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| EXAMINER |
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RICHARDSON, THOMAS W

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/761,059 | Applicant(s) PASTRO ET AL. | |
| | Examiner THOMAS RICHARDSON | Art Unit 2444 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-46 are pending for examination.

Claims 1-46 are rejected.

Response to Arguments

1. Applicant's arguments with respect to claims 1-46 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0021397, Wengrovitz and US 6 714 793, Carey et al.

4. As per claim 1, Wengrovitz teaches an apparatus for performing instant messaging (IM) under a first protocol, said apparatus comprising:

a first device (Figure 1, telephone 30);

a second device implementing a second protocol, wherein said first protocol and said second protocol comprise a telephony application protocol and a protocol supporting peer to peer services and at least one of said first device and said second device is a telephone set implementing said telephony application protocol and having a keypad having a fixed number of key buttons and a display (Figure 1, PC 40, also paragraphs 22-23, where the second device may utilize SIP, and the first may utilize PBX and CSTA protocols);

a protocol converter to convert messages between said first device and said second device to/from between said first protocol from/to said second protocol (paragraph 23, where the message is translated for delivery to the telephonic device);

a register to register said first device and said second device (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions); and

a map to map a first client to said first device and a second client to said second device, said peer to peer services including Instant Messaging (IM) (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions).

Wengrovitz does not expressly teach the telephone having full IM capability. Carey teaches a cellular instant messaging system comprising:

full IM capability is provided to said telephone set, full IM capability including creating a buddy list (column 4, lines 6-33, where the user may create an instant messaging name list).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a telephone with full IM capabilities such as that taught by Carey in a telephone-based instant messaging system such as that taught by Wengrovitz.

Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). It would be beneficial in such a system to utilize IM capabilities such as taught by Carey, as the telephone could utilize instant messaging to communicate with the PC-based client.

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5. As per claim 2, Wengrovitz further teaches said first protocol is a Session Initiation Protocol (SIP) (paragraph 22, where SIP may be utilized).

6. As per claim 3, Wengrovitz further teaches said second protocol is a Computer Supported Telephony Application (CSTA) and said protocol converter converts between CSTA and SIP/SIMPLE (paragraph 23, where the other device utilizes CSTA and PBX).

7. As per claim 4, Wengrovitz further teaches said first device is a SIP device (paragraph 22, where SIP may be utilized by the PC client).

Wengrovitz does not expressly teach utilizing presence information. Carey teaches a cellular instant messaging system comprising:

managing and determining presence information for a respective IM user (column 5, lines 58-62, where the recipient is determined to be on or off-line).

8. As per claim 5, Wengrovitz further teaches said first device is a PC (Figure 1, PC 40).

9. As per claim 6, Carey further teaches said first device is a PDA (Figure 1, mobile units 36).

10. As per claim 7, Wengrovitz further teaches said second device is said telephone set; said telephone set is a digital telephone, instant messaging being displayed on said display; and said protocol converter further manages IM capability provided to said digital telephone (Figure 1, telephone 30, also paragraph 37, where IM messages may be displayed).

Wengrovitz does not expressly teach the telephone having full IM capability. Carey teaches a cellular instant messaging system comprising:

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full IM capability is provided to said telephone set, full IM capability including creating a buddy list (column 4, lines 6-33, where the user may create an instant messaging name list).

11. As per claim 8, Wengrovitz further teaches said digital telephone is connected through a telephonic switch (paragraph 31, where the PBX may be part of a PSTN).

12. As per claim 9, Wengrovitz further teaches said telephonic switch is a PBX connected to said protocol converter using CSTA protocol (paragraph 23, where the translator may translate from PBX and CSTA).

Wengrovitz does not expressly teach the telephone having full IM capability. Carey teaches a cellular instant messaging system comprising:

full IM capability is provided to said telephone set, full IM capability including composing, retrieving, and responding to messages (column 4, lines 6-33, where the user may create an instant messaging name list).

13. As per claim 10, Wengrovitz further teaches said first device is a CSTA device (paragraph 23, where CSTA may be utilized and translated).

14. As per claim 11, Wengrovitz further teaches said first device is a telephone set and said telephone set is a digital telephone, wherein at least one key button is a programmable key (Figure 1, telephone set 30, also paragraph 21, where the telephone may include a keypad and function buttons).

15. As per claim 12, Wengrovitz further teaches said digital telephone is connected through a telephonic switch monitoring said key buttons and having full control of said

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display (paragraph 21, where the telephone may have a display and be connected to a PBX , also paragraph 7, where the message may be displayed at the telephone).

16. As per claim 13, Wengrovitz further teaches said telephone switch is a PBX connected to said protocol converter using CSTA (paragraph 23, where the translator may translate from PBX and CSTA).

17. As per claim 14, Wengrovitz teaches a method for supporting Instant Messaging (IM) in digital telephones, comprising the steps of:

registering a first protocol digital telephone set including a display and a keypad having a fixed number of key buttons (Figure 1, telephone 30, also paragraph 21, where the telephone may include a keypad and function buttons);

converting messages from said first protocol digital telephone set in said first protocol to messages in a second protocol, wherein at said first protocol is a telephony application protocol and said second protocol supports peer to peer services including Instant Messaging (IM) (paragraphs 22-23, where the second device may utilize SIP, and the first may utilize PBX and CSTA protocols, and where a message is translated for delivery to the telephone);

mapping an IM identity of a client to said digital telephone set (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions); and

communicating an instant message in one or more converted messages to or from said digital telephone set, instant messaging being displayed on said display

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(paragraph 21, where the telephone may have a display and be connected to a PBX, also paragraph 7, where the message may be displayed at the telephone).

Wengrovitz does not expressly teach the telephone having full IM capability. Carey teaches a cellular instant messaging system comprising:

full IM capability is provided to said telephone set, full IM capability including creating a buddy list (column 4, lines 6-33, where the user may create an instant messaging name list).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a telephone with full IM capabilities such as that taught by Carey in a telephone-based instant messaging system such as that taught by Wengrovitz.

Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). It would be beneficial in such a system to utilize IM capabilities such as taught by Carey, as the telephone could utilize instant messaging to communicate with the PC-based client.

18. As per claim 15, Wengrovitz further teaches registering a second device; wherein said mapping step further maps an IM identity of a second client to said second device and said instant messaging includes communicating an instant message between said first digital telephone set and said second device (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions, also Figure 1, telephone 30, also paragraph 37, where IM messages may be displayed).

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19. As per claim 16, Wengrovitz further teaches mapping a second client to said PC and said instant messaging includes communicating an instant message between said first digital telephone set and said PC (Figure 1, PC 40, also paragraphs 22-23, where the second device may utilize SIP, and the first may utilize PBX and CSTA protocols, and where a message is translated for delivery to the telephone).

20. As per claim 17, Wengrovitz further teaches said second device is a Computer Supported Telephony Application (CSTA) digital telephone set; and wherein said converting step also converts messages from said CSTA device to SIP/SIMPLE messages for a SIP device, said mapping step further maps said IM identity of said second client to said second digital telephone set and said communicating step further includes communicating an instant message between said first and said second digital telephone sets (paragraph 22, where SIP may be utilized, also paragraph 23, where the other device utilizes CSTA and PBX, and where the translator may translate from PBX and CSTA).

21. As per claim 18, Wengrovitz further teaches at least one key button is a programmable key, said method further comprising the step of configuring said at least one key button as an Instant Messaging (IM) key for a digital telephone set (Figure 1, telephone set 30, also paragraph 21, where the telephone may include a keypad and function buttons).

22. As per claim 19, Wengrovitz further teaches establishing the IM connection by pressing said instant messaging key (paragraph 21, where the telephone may include a keypad and function buttons).

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23. As per claim 20, Wengrovitz further teaches sending a notification to said digital telephone set when a new instant message arrives, said digital telephone set displaying a new instant message notification in response (paragraph 34, where the unconsulted messages may be displayed and accessed by the user).

24. As per claim 21, Wengrovitz further teaches instant messaging is accomplished while the digital telephone set is off-hook (paragraph 32, where the message may be delivered while the device is off-hook).

25. As per claim 22, Wengrovitz further teaches composing and displaying instant messages using the standard key buttons and display space of said digital telephone set (Figure 1, telephone set 30, also paragraph 21, where the telephone may include a display, keypad, and function buttons).

26. As per claim 23, Wengrovitz does not expressly teach adding client to a contact list. Sherman teaches a method for providing a network notification service wherein:

instant messaging includes sending a notification to said digital telephone set when a request to add said digital telephone set client to the contact list of another instant messaging client is received (Figure 5, step 504, also column 8, lines 5-30, where the user must provide permission to be added to other contact lists, and others may add after permission is granted).

27. As per claim 24, Wengrovitz further teaches using said digital telephone set to sign-in and sign-out for instant messaging services (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions).

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28. As per claim 25, Wengrovitz does not expressly teach changing the status of a device. Sherman teaches a method for providing a network notification service wherein:

instant messaging includes using said digital telephone set to change the on-line and off-line status of said digital telephone set (Figure 3, where status information is displayed for other users, also column 6, lines 23-59, where the device may be turned on or off to change availability status).

29. As per claim 26, Wengrovitz does not expressly teach maintaining the status of users. Sherman teaches a method for providing a network notification service wherein:

communicating includes using said digital telephone set to query the status of a contact list member (Figure 3, where status information is displayed for other users).

30. As per claim 27, Wengrovitz does not expressly teach maintaining the status of users. Sherman teaches a method for providing a network notification service wherein:

communicating includes determining the presence status of said digital telephone based on call activity of said digital telephone (Figure 3, where status information is displayed for other users).

31. Claims 32-46 list all the same elements of claims 1-5, 7-11, and 14-18, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claims 1-5, 7-11, and 14-18 applies equally as well to claims 32-46.

32. Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0021397, Wengrovitz and US 7 020 460, Sherman et al as applied to claim 14 above, and further in view of US 2005/0013421, Chavez et al.

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33. As per claim 28, Wengrovitz does not explicitly teach: instant messaging includes sending stored common replies to other instant messaging clients. In the same field of endeavor, Chavez teaches, (paragraph 86) the message is saved and then sent as a response.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

34. As per claim 29, Wengrovitz does not explicitly teach: at least one of said stored common replies includes at least one custom data field. 62 In the same field of endeavor, Chavez teaches, (paragraph 86) the stored text message is a text response created by the user.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so,

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by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

35. As per claim 30, Wengrovitz does not explicitly teach: instant messaging includes sending stored common messages to other instant messaging clients. In the same field of endeavor, Chavez teaches, (paragraphs 87-88) the stored text message is transmitted in response to the sender.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

36. As per claim 31, Wengrovitz does not explicitly teach: at least one of said stored common replies includes at least one custom data field. 68. In the same field of endeavor, Chavez teaches, (paragraph 22) stored text messages are associated or mapped to keys, these messages can be customized by the user.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched

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communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

Conclusion

Examiner would like to make some suggestions for expediting prosecution of application:

37. In independent claims: further definition of the protocols, and their relation to each other, such as on page 6 of the specification, where each has a proxy server interfacing, and such that the two protocols do not interface directly with each other; further definition of the instant messaging processing, such as found on page 7 of the specification, where the processing takes place at the SIP proxy; further definition of the PBX IM application, such as found on page 7 of the specification, where the IM process for the telephone is managed. These, along with any other applicant clarifications, may help expedite prosecution of the application, as it would more clearly differentiate from the prior art of record by defining the relationship between the IM application and the proxy servers within the system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS RICHARDSON whose telephone number is (571) 270-1191. The examiner can normally be reached on Monday through Thursday, 8am-5pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TR

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444